

REMARKS

An Excess Claim Fee is submitted herewith for two excess total claims.

Claims 1-16, 19-20 and 22-25 are all the claims presently pending in the application. Claims 1, 3, 4, 6, 13, 14, 16 and 19-20 have been amended to more particularly define the invention.

While the claim amendments made herein may help to distinguish the invention over the prior art, Applicant's intention in making the amendments is for the purpose of particularly pointing out the invention, and not for the purpose of distinguishing the invention over the prior art, narrowing the claims, or for any statutory requirements of patentability. Further, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1-2, 6-7, and 12-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausubel (U.S. Patent No. 5,905,975) in view of Wellman (U. S. Patent No. 6,952,682).

Claims 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausubel, Wellman and further in view of McAfee, et al. (U.S. Patent No. 6,718,312 B1) (hereinafter "McAfee").

Claims 8-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausubel, Wellman, and further in view of Macready, et al. (U.S. Publication No. 2002/0016759) (hereinafter "Macready").

Claims 14, 16, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausubel, Wellman, and McAfee, and further in view of Macready.

Claims 15 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausubel, Wellman, McAfee and Macready, and further in view of Official Notice.

These rejections are respectfully traversed in view of the following discussion.

I. THE CLAIMED INVENTION

An exemplary aspect of the claimed invention (e.g., as recited in claim 1) is directed to a computer implemented method for an auction which includes establishing an auction system which is accessible via a network, and performs an auction for a plurality of items including an item and an other item which is different than the item, generating by using a processor, a web page including a user interface for entering a bid in the auction, the user interface displaying an area for entering a bid for the item and the other item, an area for entering a condition associated with a set of items including the item and the other item, and an area for editing the condition, receiving a bid for the item and a condition associated with the set of items which are entered by a bidder by using the user interface, displaying on the user interface a bid table for indicating that the bid is one of a selected bid and an unselected bid during a course of the auction, formulating a winner determination problem including the condition associated with the set of items as an integer program, and solving the integer program to determine whether the bid is a selected bid, receiving an edit to the condition which is entered by the bidder by using the user interface, and updating the bid table displayed on the user interface to indicate that the bid is one of a selected bid and an unselected bid based on the edited condition, and upon terminating the auction, updating the bid table displayed on the user interface to indicate that the bid is one of a winning bid and a non-winning bid (Application at Figure 2A-2B and 6; page 7, lines 3-16).

As explained beginning at line 11 on page 3 of the specification, conventional methods do not enable auction participants to specify a condition that describes or characterizes an item or a combination of items that they wish to win or sell. Nor do conventional methods allow a bidder to edit such a condition.

The claimed invention, on the other hand, includes generating by using a processor, a web page including a user interface for entering a bid in the auction, the user interface displaying an area for entering a bid for the item and the other item, an area for entering a condition associated with a set of items including the item and the other item, and an area for editing the condition (Application at Figure 2A-2B and 6; page 7, lines 3-16). These features may enable auction participants to specify a condition that describes or characterizes an item

or a combination of items that they wish to win or sell, and allow a bidder to edit such a condition.

II. THE ALLEGED PRIOR ART REFERENCES

A. Ausubel and Wellman

The Examiner alleges Ausubel makes obvious the invention of claims 1-2, 6-7, and 12-13. Applicant submits, however, that these alleged references would not have been combined and even if combined, the combination would not teach or suggest each and every feature of the claimed invention.

Indeed, Applicant submits that these alleged references are completely unrelated, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

In fact, Applicant submits that the alleged references provide no motivation or suggestion to urge the combination as alleged by the Examiner. Indeed, these alleged references clearly do not teach or suggest their combination. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the alleged references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Ausubel, nor Wellman, nor any alleged combination thereof teaches or suggests "*generating by using a processor, a web page including a user interface for entering a bid in said auction, said user interface displaying an area for entering a bid for said item and said other item, an area for entering a condition associated with a set of items including said item and said other item, and an area for editing said condition*", as recited in claim 1 and similarly recited in claims 13-14 and 20 (Application at Figure 2A-2B and 6; page 7, lines 3-16).

Clearly this feature is not taught or suggested by Ausubel.

Indeed, the Examiner attempts to rely on col. 6, line 27 and col. 7, line 66 to col. 8, line 19 to support his position that Ausubel teaches the "user interface" of the claimed invention, and attempts to col. 2, lines 64-65 and col. 3, lines 59-62 in Ausubel to support his

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position that Ausubel teaches displaying "to the bidding participant that he has won a bid at a specific combination of price and unit volume..." (Office Action at page 3). The Examiner is clearly incorrect.

In fact, these passages simply teach that Bidder's computer may include "a typical user interface such as a keyboard and display" (Ausubel at col. 6, lines 26-28), and that the user interface is "coupled to a communication interface" (Ausubel at col. 8, lines 2-3), and sending a final message containing the results of the auction (Ausubel at col. 3, lines 59-61). That is, nowhere does Ausubel teach or suggest generating a web page including a user interface for entering a bid in the auction, the user interface displaying an area for entering a bid for the item and the other item, an area for entering a condition associated with a set of items including the item and the other item, and an area for editing the condition.

Likewise, Wellman does not teach or suggest these features.

In fact, the Examiner attempts to rely on col. 13, lines 34-41 in Wellman to support his position. In particular, the Examiner alleges that "[d]isseminating in a computer automated system is the equivalent to causing to display auction results on a user interface". However, the Examiner is clearly incorrect.

Indeed, Wellman simply teaches seller input screen 200 and buyer input screen 300. The input screen 300 allows a buyer to input a set of predefined attributes and specify a nominal set of values for the predefined attributes (Wellman at col. 5, lines 42-60).

Further, Wellman teaches in col. 13, lines 34-41 that in step 1004 "each matched pair of seller and buyer is notified of the match as well as the matched values of the attributes". However, Applicant would point out that "notified" does not necessarily mean generating a web page. In fact, the seller and buyer could be "notified" by phone, text message or telegram. Therefore, Applicant does not understand how the Examiner could assume from this passage that Wellman teaches "disseminating in a computer automated system". Moreover, even assuming (arguendo) that Wellman teaches disseminating in a computer automated system, this would not necessarily "cause a display", and thus, would clearly not be equivalent to "causing to display auction results" as alleged by the Examiner.

That is, like Ausubel, Wellman does not teach or suggest generating a web page including a user interface for entering a bid in the auction, the user interface displaying an area for entering a bid for the item and the other item, an area for entering a condition associated with a set of items including the item and the other item, and an area for editing the condition.

Further, the Examiner states that a bid "implicitly" includes at least one condition on winning an item, such as a price at a minimum (Office Action at page 3); that Ausubel "implicitly" discloses that bids below this price were unselected (Id); that "it is implicit that Ausubel uses an integer program to determine whether said bid is selected" (Office Action at page 4); that Ausubel's method has "inherent" seller conditions (Office Action at page 5); that a web page is "implied" by the worldwide web (Office Action at page 6); and that an alternate precedence constraint is "implicit" in the various combinations concept of a plurality of constraints (Office Action at page 14). Presumably, by the term "implicit" or "implicitly" the Examiner means that the features are "inherent".

However, Applicant would point out that MPEP 2112 (IV) provides that **the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient** to establish the inherency of that result or characteristic. (e.g., see *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). That is, inherency, may not be established by probabilities or possibilities (e.g., see *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Further, MPEP 2112 (IV) also provides that in relying upon the theory of inherency, **the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.** (e.g., see *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

However, in this case, the Examiner has failed to provide any basis to support his assertion that the features of the claimed invention "necessarily flow" from the teachings of the references. Therefore, the Examiner has failed to show that the features are inherent.

Therefore, Applicant submits that these alleged references would not have been

combined and even if combined, the combination would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

B. McAfee and Macready and Official Notice

The Examiner alleges that Ausubel and Wellman would have been further combined with McAfee to form the invention of **claims 3, 4 and 5**, and further combined with Macready to form the invention of **claims 8-11**, further combined with McAfee and Macready to form the invention of **claims 14, 16, 19** and further combined with McAfee and Macready (and Official Notice) to form the invention of **claims 15 and 20**. Applicant submits, however, that these alleged references would not have been combined and even if combined, the combination would not teach or suggest each and every feature of the claimed invention.

Indeed, Applicant submits that these alleged references are completely unrelated, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

In fact, Applicant submits that the alleged references provide no motivation or suggestion to urge the combination as alleged by the Examiner. Indeed, these alleged references clearly do not teach or suggest their combination. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the alleged references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Ausubel, nor Wellman, nor McAfee, nor Macready, nor Official Notice, nor any alleged combination thereof teaches or suggests *"generating by using a processor, a web page including a user interface for entering a bid in said auction, **said user interface displaying an area for entering a bid for said item and said other item, an area for entering a condition associated with a set of items including said item and said other item, and an area for editing said condition**"*, as recited in claim 1 and similarly recited in claims 13-14 and 20 (Application at Figure 2A-2B and 6; page 7, lines 3-16).

Clearly, this feature is not taught or suggested by the cited references.

Indeed, McAfee simply teaches using bid composition restrictions in a "dynamic combinatorial auction". The restrictions include non-additive activity restrictions, subset restrictions and superset restrictions (McAfee at Abstract).

However, even assuming (arguendo) that McAfee teaches "constraints" as alleged by the Examiner, nowhere does McAfee teach or generating a web page including a user interface for entering a bid in the auction, the user interface displaying an area for entering a bid for the item and the other item, an area for entering a condition associated with a set of items including the item and the other item, and an area for editing the condition, as in the claimed invention.

Likewise, Macready does not teach or suggest this feature of the claimed invention. Indeed, Macready does not even teach or suggest an auction. Instead, Macready simply teaches a level of optimization which ranks trades with suppliers, allegedly allowing a buyer to determine the best alternative (Macready at [0002]).

That is, even assuming (arguendo) that Macready teaches "constraints", nowhere does McAfee teach or generating a web page including a user interface for entering a bid in the auction, the user interface displaying an area for entering a bid for the item and the other item, an area for entering a condition associated with a set of items including the item and the other item, and an area for editing the condition, as in the claimed invention.

Therefore, neither McAfee nor Macready, make up for the deficiencies of Ausubel and Wellman.

Further, with respect to claims 15 and 20, Applicant would point out that the Examiner attempts to take Official Notice that a feature of these claims (e.g., *"wherein said integer program is expressed by the following, subject to conditions specified by bidders in said auction:*

$$\text{Max} \sum_{i, p} v_{i, p} x_{i, p}$$

where $v_{i, p}$ denotes a monetary value of a bid that bidder p has placed for item i , and, $x_{i, p}$

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*denotes a decision variable having a value of 0 when said bid is not in a winning combination, and 1 when said bid is a winning combination", is well-known. However, Applicant would point out that **this feature is clearly not capable of instant and unquestionable demonstration as being well-known**, and therefore, it is **not appropriate** for the Examiner to attempt to take "Official Notice" of these alleged facts (e.g., see MPEP §2144.03). Further, the Examiner **must provide Applicant with the explicit basis** on which the Examiner regards the matter as subject to Official Notice. Moreover, Applicant would point out to the Examiner that in response to Applicant's traversal of the Examiner's assertion of such "Official Notice", **the Examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.***

Therefore, Applicant submits that these alleged references would not have been combined and even if combined, the combination would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-16, 19-20 and 22-25, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

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